

REMARKS

Claims 2 and 5-20 are pending in the instant application. Claims 2, 5-10 and 12-16 have been rejected. Claim 2 has been amended. Support for these amendments can be found in the specification. Claims 5, 11 and 17-20 have been cancelled. After entry of these arguments, Claims 2, 6-10 and 12-16 will remain pending.

Rejection of Claims 2, 5, 6, 7, 8, 9, 10, 12, and 14-16 under 35 USC §112, first paragraph

The Examiner has rejected Claims 2, 5, 6, 7, 8, 9, 10, 12, and 14-16 under 35 USC §112, first paragraph as allegedly lacking enablement. The Examiner alleges that the specification is only enabling for using the compounds of formula I with R¹ as a substituted carbonyl moiety, R⁶ as an optionally substituted phenyl, and R⁹ as hydrogen or $-(CH_2)_3NH_2$.

Applicants respectfully traverse this rejection. Without conceding the correctness of the Examiner's rejection, but to advance the prosecution of the instant application, Applicants have amended Claim 2 to incorporate the limitations defined in Claim 5 for R¹. With regard to the Examiner's objection to the scope of R⁹, Applicants would like to direct the Examiner's attention to the compounds described on pages 56-59, which exemplify many alkylamino and alkylhydroxy substituted derivatives.

Applicants respectfully contend that the current focus of Claim 2 mirrors the specific compounds that have been made and tested to exemplify the claimed invention. Applicants respectfully contend that the specific example compounds whose syntheses and testing is described in the application and the Reaction Schemes set out in the application together would readily allow one of ordinary skill in the art to make, use and test the claimed compounds without any undue additional experimentation.

In light of these amendments, Applicants respectfully request the rejection of Claims 2, 5, 6, 7, 8, 9, 10, 12, and 14-16 under 35 USC §112, first paragraph, be withdrawn.

Commonly Owned Subject Matter

Applicants contend that the inventions contained in the instant application and in the application of Serial Number 10/539,531 were both assigned to Merck & Co., Inc.

Nonstatutory Obviousness-type Double Patenting Rejection of Claims 2, 9, 13, 14 and 15

The Examiner has provisionally rejected Claims 2, 9, 13, 14 and 15 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 2, 90, 11, 13, 14 and 15 of co-pending Application No. 10/539,531. As these rejections are provisional rejections based on pending applications which are still undergoing prosecution and wherein no allowable subject matter has yet been identified, Applicants respectfully request that this rejection be held in abeyance.

If a telephonic communication with the Applicants' representative will advance the prosecution of the instant application, please telephone the representative indicated below. Applicants believe no additional fees are due but the Commissioner is authorized to charge any fees required in connection with this response to Merck Deposit Account No. 13-2755.

Respectfully submitted,

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